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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,822	08/27/2001	Takahiro Tomida	01520/LH	6670

1933 7590 06/15/2006

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EXAMINER

HUNTSINGER, PETER K

ART UNIT PAPER NUMBER

2625

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,822

Applicant(s)

TOMIDA ET AL.

Examiner

Peter K. Huntsinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/27/06 has been entered.

Response to Arguments

2. Applicant's arguments filed 3/27/06 have been fully considered but they are not persuasive.

The applicant argues on page 11 of the response in essence that:

Safai et al. do not teach designating pre-stored images on a server.

a. Safai et al. disclose uploading images that are stored on a server (col. 15, lines 33-40). The camera can connect to the server at a later time and download the images so the images. Thus, the images can be considered pre-stored on a server.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 37 recites the limitation "the server" in lines 3 and 4 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 37 is rejected under 35 U.S.C. 102(e) as being anticipated by Safai et al.

Patent 6,167,469.

Referring to claim 37, Safai et al. disclose a method comprising: acquiring a caller's number of a portable communication terminal (col. 13, lines 54-65), when the portable communication terminal accesses a server through a network (col. 13, lines 39-47); causing the portable communication terminal to display thumbnails corresponding to pre-stored images on the server (col. 10, lines 33-37); determining, at the server, whether the portable communication terminal has issued a registration command to register at least one of the images on the server corresponding to at least one of the thumbnails displayed by the portable communication terminal (col. 13, lines 10-24); and

relating, at the server, the at least one selected image with the caller's number and storing the selected image in association with the caller's number when it is determined that the portable communication terminal has issued the registration command (col. 14, lines 35-39) (col. 13, lines 39-47).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai et al. Patent 6,167,469, Taniguchi et al. Patent 6,348,972, and Dervarics Patent 6,553,240.

Referring to claim 38, Safai et al. disclose a print method comprising: connecting a portable communication terminal to a server through a network (col. 3, lines 47-52); displaying, on the portable communication terminal, thumbnails corresponding to pre-stored images on the server (col. 10, lines 25-32); selecting, at the portable communication terminal, at least one of the thumbnails (col. 10, lines 25-32); transmitting, from the portable communication terminal to the server, a registration command for relating the at least one pre-stored image corresponding to the at least one selected thumbnail (col. 13, lines 10-24) with a caller's number of the portable communication terminal, and storing the at least one selected image in association with

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the related caller's number on the server (col. 13, lines 39-65); disconnecting the portable communication terminal from the server (col. 14, lines 1-8). The images displayed on the portable communication terminal correspond to images on the server because the images may be retained on the portable communication terminal after they have been uploaded onto the server. Sinai et al. do not disclose expressly connecting the printer when a print command has been issued. Dervarics discloses connecting the printer to the server through the portable communication terminal, when it is determined that a print command has been issued (col. 7, lines 30-32). Safai et al. and Dervarics are combinable because they are from the same field of printing from portable devices. At the time of the invention, it would have been obvious to one of ordinary skill in the art connect a printer to a portable communication terminal when a print command has been issued. The motivation for doing so would have been to only connect the printer with the portable communication terminal when it is necessary and not continually maintain a connection. Safai et al. do not disclose expressly issuing a print command at the printer. Taniguchi et al. disclose determining whether a print command has been issued at a printer (col. 6, lines 61-67); transmitting a download request from the printer to the server after the print command has been issued (col. 7, lines 16-19); receiving at the printer the at least one image, which is transmitted from the server in response to the download request (col. 7, lines 34-39); and printing at the printer at least one received image (col. 7, lines 38-39). Safai et al. and Taniguchi et al. are combinable because they are from the same field of image processing. At the time of the invention, it would have been obvious to one of ordinary skill in the art allow issuing print commands from

a printer. The motivation for doing so would have been to provide protection against unauthorized printing of documents. Therefore, it would have been obvious to combine Taniguchi et al. and Dervarics with Safai et al. to obtain the invention as specified in claim 38.

Referring to claim 39, Safai et al. disclose a print system comprising: means for connecting a portable communication terminal to a server through a network (col. 6, lines 5-19); means for acquiring a caller's number of the portable communication terminal, when the portable communication terminal accesses the server (col. 13, lines 54-65); means for displaying, on the portable communication terminal, thumbnails corresponding to pre-stored images on the server (col. 10, lines 33-37); means for selecting, at the portable communication terminal, at least one of the thumbnails (col. 10, lines 25-32); means for relating, at the server, the at least one selected pre-stored image with the caller's number and for storing the at least one selected image in association with the caller's number (col. 13-14, lines 66-67, 1); means for disconnecting the portable communication terminal communication from the server (col. 14, lines 1-8). The images displayed on the portable communication terminal correspond to images on the server because the images may be retained on the portable communication terminal after they have been uploaded onto the server. Sinai et al. do not disclose expressly connecting the printer when a print command has been issued. Dervarics discloses means for connecting the printer to the server through the portable communication terminal when a print command is issued (col. 7, lines 30-32). Safai et al. and Dervarics are combinable because they are from the same field of

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printing from portable devices. At the time of the invention, it would have been obvious to one of ordinary skill in the art connect a printer to a portable communication terminal when a print command has been issued. The motivation for doing so would have been to only connect the printer with the portable communication terminal when it is necessary and not continually maintain a connection. Safai et al. do not disclose expressly issuing a print command at the printer. Taniguchi et al. disclose means for transmitting a download request from the printer to the server after a print command has been issued (col. 7, lines 16-19); means for receiving the at least one image, which is transmitted from the server in response to the download request (col. 7, lines 34-39); and means for controlling the printer to print the at least one received image (col. 7, lines 38-39). Safai et al. and Taniguchi et al. are combinable because they are from the same field of image processing. At the time of the invention, it would have been obvious to one of ordinary skill in the art allow issuing print commands from a printer. The motivation for doing so would have been to provide protection against unauthorized printing of documents. Therefore, it would have been obvious to combine Taniguchi et al. and Dervarics with Safai et al. to obtain the invention as specified in claim 39.

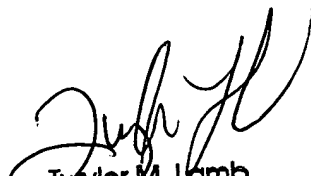
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH



Twyler M. Lamb
Supervisory Patent Examiner